

REMARKS

This reply is in response to the Office Action mailed on August 9, 2007 in which Claims 16-24 were allowed; in which Claims 7-9, 31 and 32 were objected to and in which Claims to 1-3, 5, 6, 10 -14, 25 30 and 33-37 were rejected. With this response, claims 32 and 36 are canceled; claims 1, 25, 33, 35 and 37 are amended; and claims 38 is added.. Claims 1-3, 5-14, 16-25, 30-31, 33-35 and 37-38 are presented for reconsideration and allowance. are presented for reconsideration and allowance.

I. Examiner Interview Summary

On November 9, 2007, a telephonic interview was held between Examiner Mackey and Applicant's attorney, Todd A. Rathe. The denial of patentable weight to "additional limitations" and functional limitations was discussed. Although no agreement was reached, Applicants wish to thank Examiner Mackey for the opportunity to discuss the Examiner's positions.

II. Objection to claims 35 and 37

Section 1 of the Office Action objected to claims 35 and 37 noting several informalities. Claims 35 and 37 are amended to correct such informalities.

III. Rejection of Claims 33 and 37 under 35 USC 112, Second Paragraph

Section 2 of the Office Action rejected claim 33 and 37 by noting that the limitation "the document processing module" in claims 33 and 37 lacks antecedent basis. In response, both claims 33 and 37 are amended to now recite a document processing apparatus which finds antecedent basis in the same claim. Accordingly, claims 33 and 37, as amended, overcome the rejection under 35 USC 112, second paragraph.

IV. Rejection of Claims 1-3, 5-6, 10, 12-14, 25, 30 and 33-37 under 35 USC 102(b) Based upon Nakamura or under 35 USC 103(a) Based upon Nakamura and Miyauchi.

Section 3 of the Office Action rejected claims 1, 5, 10, 12-14 and 25 under 35 USC 102(b) as being anticipated by Nakamura et al. US Patent 5,419,543 or, in the alternative, under 35 USC 103(a) as being obvious over Nakamura in view of Miyauchi et al. US Patent 5,742,318. For the reasons which follow, Applicants respectfully request that the rejection be withdrawn.

A. Claim 1

Section 6 of the Office Action indicated that claim 32 would be allowable if rewritten in independent form so as to include all of the limitations of the base claim and any intervening claims. In response, claim 1 is amended to incorporate the limitations of former dependent claim 32. Thus, claim one is believed to be patentably distinct over the prior art of record. The rejection of claims 2-3, 5-6, 10 and 12-14 which depend from claim 1 should also be withdrawn.

B. Claim 25

Claim 25, as amended, recites a sheet transfer apparatus which includes a first roller driven at a first surface speed, a second roller driven at second surface speed, a drive gear operably coupled to the first roller, (1) means for cessating transmission of power to the drive gear and rotationally driving the second roller while creating a dwell after the first roller and the second roller have initially and simultaneously engaged a media sheet and (2) means for consuming the dwell automatically in response to disengagement of the media sheet from the first roller and while rotationally driving the second roller. Support for the amendment to claim 25 may be found in the Paragraph [0028] and Figures 4 and 4a of the present application which describe the creation of a dwell. Thus, no new matter is believed to be added.

Neither Nakamura nor Miyauchi, alone or in combination, disclose or suggest an apparatus having means for consuming the dwell automatically in response to disengagement of the media sheet from the first roller and while rotationally driving the second roller. In rejecting claim 25, the Office Action asserted that movement of gear 64 (in Figure 2) in the direction of the broken line Aero constitutes creation of

dwelling. However, nowhere does Nakamura disclose that this movement of gear 64 is done automatically in response to a media sheet being disengaged from the roller 21. Moreover, it appears to be mechanically impossible for Nakamura to move gear 64 in a clockwise direction back towards feeding gear 55 (characterized by the Office Action as the consumption of dwell) while at the same time continuing to drive roller 54 (characterized as the second roller by the Office Action). Clearly, as soon as gear 64 is moved towards gear 55 and out of engagement with gear 54, geared 54 can no longer be driven. Accordingly, claim 25, as amended, overcomes the rejection based upon Nakamura alone or based upon Nakamura and Miyauchi. Claim 37 depends from claim 25 and overcomes the rejection for at least the same reasons.

C. Claims 2, 3, 6, 30, 34 and 35

Claims 2, 3, 6, 30, 34 and 35 depend from claim 1 and are patentably distinct over the prior art of record for the same reasons discussed above with respect to claim 1. Claims 30, 34 and 35 recite additional features which further patentably distinguish such claims over the prior art of record including Nakamura and Miyauchi.

In rejecting such claims, the Office Action asserted that (1) such claims include "conditional limitations" which are not entitled to patentable weight and (2) with respect to claim 35, the functional claim limitations are not entitled compatible weight pursuant to MPEP 2114.

Applicants respectfully disagree on all counts. First, such claim limitations are not "conditional limitations." Such limitations merely recite that the devices are configured such that a first action occurs in response to a second action. This is no different than a recitation of a motor driving a gear in response to control signals from a controller.

Second, MPEP 2173.05(g) clearly indicates that functional claim limitations are permitted and are entitled patentable weight. MPEP 2114 does not contradict

MPEP 2173.05(g). In contrast, the Office Action appears to take MPEP 2114 out of context. MPEP 2114 appears to correctly stand for the proposition that the absence of a disclosure in a prior art reference relating to a function recited in a functional claim limitation does not defeat a finding of anticipation when the structure of the prior art reference inherently performs the recited function. See *In re Schreiber*, 128 F.3d 1473, 1477-78. MPEP 2114 does not stand for the proposition that functional claim limitations should be denied patentable weight.

V. Rejection of Claim 11 under 35 USC 103(a) Based upon Nakamura and Velasquez or Based upon Nakamura, Miyauchi and Velasquez

Section 4 of the Office Action rejected claim 11 under 35 USC 103(a) as being unpatentable over Nakamura US Patent 5,419,543 in view of Velasquez US Patent Publication 2002/0179222 or alternatively under 35 USC 103(a) as being unpatentable over Nakamura US Patent 5,419,543 in view of Miyauchi US Patent 5,742,318 and further In view of Velasquez US Patent Publication 2002/0179222. Claim 11 depends from claim 1 and overcomes the rejection for the same reasons discussed above with respect to claim 1. Velasquez fails to satisfy the deficiencies of Nakamura or Miyauchi.

VI. Added Claim 38

With this response, claim 38 is added. Claim 38 is believed to be patentably distinct over the prior art of record.

Section 6 of the Office Action indicated that claim 31 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response, claim 31 is rewritten in independent form as added claim 38. Accordingly, claim 38 is presented for consideration and allowance.

VII. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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